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Expedited Examining Procedure
Group 1772PATENT
Docket No. 55090US002**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s):	Eric E. RICE et al.)	Group Art Unit:	1772
Serial No.:	09/929,417)	Examiner:	Patricia L. Nordmeyer
Confirmation No.:	1221)		
Filed:	14 August 2001)		
For:	COMPOSITE PAVEMENT MARKINGS)		

RESPONSE UNDER 37 CFR §1.116Commissioner for Patents
Mail Stop AF
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Final Office Action mailed 20 October 2003 has been received and reviewed. The pending claims are claims 1-31, of which claims 1-24 are currently under examination.

Reconsideration and withdrawal of the rejections in view of the following comments are respectfully requested.

Information Disclosure Statement

An Information Disclosure Statement was filed in connection with this application on May 7, 2002. This Information Disclosure Statement included a 1449 form listing the European Patent documents 0 683 270 B1 and 0 683 270 A2 & A3. An initialed copy of this 1449 form has not, however, been returned to Applicants. It is therefore requested that, pursuant to the provisions of M.P.E.P. §609, a copy of this 1449 form, marked as being considered and initialed

EXPEDITED EXAMINING PROCEDURE REQUESTEDPATENT
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For: COMPOSITE-PAVEMENT-MARKINGS

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Mueting, Raasch & Gebhardt, P.A.

19 FEB. 2004

Date

By: KW Raasch

Kevin W. Raasch

Reg. No. 35,651

Direct Dial (612)305-1218

CERTIFICATE UNDER 37 C.F.R. §1.8: The undersigned hereby certifies that this Facsimile Cover Sheet and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office addressed to the Commissioner for Patents, Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19th day of February, 2004, at 3:30 PM (Central Time).

19 FEB. 2004

Date

Signature: KW RaaschName: KEVIN W. RAASCH

If you do not receive all pages, please contact us at (612)305-1220 (ph) or (612)305-1228 (fax).

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by the Examiner, be returned with the next Official Communication. A copy of the 1449 form is included herewith for the Examiner's convenience.

Withdrawn Rejections

Applicants note, with thanks, the withdrawal of the 35 U.S.C. §102(b) rejection of claims 1-3, 7-9, 14, and 23-24 as anticipated by Eigenmann and the 35 U.S.C. §103 rejection of claims 4-6, 13, 15-18, 21, and 22 over Eigenmann in view of Wyckoff in Paper #11.

The 35 U.S.C. §103 Rejections

The Examiner maintained the rejection of claims 10-12 under 35 U.S.C. §103(a) as being unpatentable over Eigenmann (U.S. Patent No. 4,129,673) in view of Jonnes (U.S. Patent No. 3,785,719). Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations (M.P.E.P. §2143).

Applicants assert that there is no motivation to combine Eigenmann with Jonnes. Eigenmann teaches a roadway surface marking tape material including components for raising snowplow implements over retroreflective elements, thus preventing destruction of the retroreflective elements by the snowplow (Eigenmann, Abstract).

Jonnes, conversely, teaches a roadway lane delineator including an integrally formed base portion and reflector portion that forms a retroreflective structure, wherein the retroreflective structure elastically deforms when engaged by a vehicle passing over the structure (Jonnes, column 1, lines 52-59 and column 1, line 65 to column 2, line 5).

Because the retroreflective structure of Jonnes is intended to deform upon contact by a passing vehicle, the assertion (made in support of this rejection) that Jonnes teaches "that the side

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rails protect the retroreflective elements . . . " is not supported by the reference itself. As a result, the asserted motivation to combine the teachings of Eigenmann with Jonnes is also not supported. In the absence of a properly-supported motivation to combine Eigenmann and Jonnes, Applicants submit that a proper *prima facie* case of obviousness has not been established.

In essence, Eigenmann and Jonnes teach two completely different approaches to solving the problem of snowplows and the Office Action provides no reasoning as to why or how one of ordinary skill in the art could make the proposed modification. For that reason alone, Applicants submit that a *prima facie* case of obviousness has not been established.

Furthermore, a combination of the teachings of Eigenmann and Jonnes fails to teach or suggest all elements of Applicants' claims. Independent claim 1 is directed to a composite pavement marking including, *inter alia*, a first portion having a first portion width and a unitary retroreflective article attached to the first portion, wherein the unitary retroreflective article has a width that is substantially equal to the first portion width. Claims 10-12, dependent directly or ultimately from claim 1, thus also include a composite pavement marking having a first portion width and a unitary retroreflective article attached to the first portion, wherein the unitary retroreflective article has a width that is substantially equal to the first portion width.

As indicated in Applicants' response to the U.S.C. §102(b) rejection of claim 1 in view of Eigenmann filed September 15, 2003, Eigenmann fails to teach a unitary retroreflective article having a width that is substantially equal to the first portion width. Applicants further submit herein that there is no suggestion to one skilled in the art to so modify the teachings of Eigenmann. Furthermore, Jonnes, which discloses a monolayer of embedded retroreflective elements, such as transparent glass microspheres or beads (col. 2, lines 21-28 and col. 3, lines 39-41), also fails to teach or suggest a unitary retroreflective article having a width that is substantially equal to the first portion width.

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For the above reasons, Applicants respectfully submit that claims 10-12 are patentable over the asserted combination of Eigenmann and Jonnes. Reconsideration and withdrawal of the rejection are respectfully requested.

The Examiner maintained the rejection of claims 19-21 under 35 U.S.C. §103(a), in the present Office Action asserting these claims as being unpatentable over Eigenmann (U.S. Patent No. 4,129,673) in view of Wyckoff (U.S. Patent No. 5,108,218) and further in view of Jonnes (U.S. Patent No. 3,785,719). Applicants respectfully traverse this rejection.

With respect to claim 21, Applicants note that the rejection does not discuss, in any manner, how the cited references teach or suggest the use of two colors as recited in claim 21. For that reason alone, Applicants respectfully submit that the rejection of claim 21 over the combination of Eigenmann in view of Wyckoff and Jonnes does not meet the requirements for a proper *prima facie* case of obviousness and must be withdrawn.

With respect to claims 19 and 20, Applicants provide the following remarks.

For the reasons stated above with respect to the rejection of claims 10-12, Applicants submit that there is no proper motivation to combine the teachings of Eigenmann with those of Jonnes.

The rejection also begins with a discussion of "Eigenmann, as modified by Wyckoff. . . ." but provides no real discussion as to how Eigenmann would be modified by Wyckoff. Applicants respectfully request a discussion as to how Eigenmann is to be modified and the asserted motivation that would lead one of ordinary skill in the art to make the proposed modification(s). In the interests of compact prosecution, however, Applicants respectfully submit that one of ordinary skill in the art would not be motivated to combine the teachings of Eigenmann with those of Wyckoff, and any such combination may only occur through impermissible hindsight reconstruction.

Eigenmann teaches a roadway surface marking tape material including components for raising snowplow implements over retroreflective elements, thus preventing destruction of the

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retroreflective elements by the snowplow (Eigenmann, Abstract). Wyckoff teaches a roadway marking strip wherein a flat rubber sheet is coated with glass beads, and embossed with a wedge pattern embossing drum such that, during the process of embossing, the surface of the rubber sheeting is deformed in the glass beaded area only, and the beads are partially pressed into the wedge tops and near vertical faces of the wedges and almost completely pressed into the valley floors (Wyckoff, column 4, lines 35-58).

The object of Wyckoff is to provide a roadway marking strip that would prevent obscuring of the strips under conditions of both low sun angles during the day and high levels of overhead ambient light during the night (Wyckoff et al., col. 1, lines 40-55). There is no teaching or suggestion whatsoever that the roadway marker strip of Wyckoff would raise snowplowing implements or otherwise prevent destructive action to the strip by snowplowing means, as is found in Eigenmann (Eigenmann, Abstract). Thus, there is no incentive for one skilled in the art to look to Wyckoff to find a solution to the damage created by snowplowing means.

It is asserted that to combine the teachings of Eigenmann with those of Wyckoff, one must rely on impermissible hindsight using Applicants' disclosure as a template. One cannot, however, "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, the suggestion for combining the teachings of the prior art to make the invention must be founded in the prior art and not in the teachings of Appellants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Applicants submit that it is impermissible for the Examiner to simply search the art to fill in that which is missing from Eigenmann to attempt to provide Applicants' invention when there is no motivation to make such combination in the prior art.

Additionally, even if the teachings of Wyckoff and of Jonnes were combined with the teachings of Eigenmann, the combination would still fail to teach or suggest each and every element of Applicants' claims.

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Claims 19 and 20 each depend, directly or ultimately, from independent claim 15, which claims a composite pavement marking that, *inter alia*, includes: a plurality of discrete first portions surrounded by a second portion, each of the plurality of first portions comprising a discrete unitary retroreflective article attached thereto. It is asserted that neither Eigenmann, Wyckoff, nor Jonnes teach or suggest the discrete unitary retroreflective article of claim 15.

The unitary retroreflective article of Applicants' invention "includes two sides . . . and a top surface" (specification, page 7, lines 10-11). Eigenmann teaches retroreflective elements having a protruding dome or part-spherically shaped protruding portion (Eigenmann, col. 4, lines 29-31) which are not the unitary retroreflective articles of Applicants' invention.

Wyckoff teaches marking strip surfaces including a coating a layer of glass beads on a sheet and embossing them therein (Wyckoff, col. 4, lines 40-54). Jonnes, likewise, teaches forming a layer of retro-reflective articles such as glass beads on a surface of the roadway lane delineator to form a monolayer of retro-reflective elements (Jonnes, col. 2, lines 43-54). Such layers of beads are not the discrete unitary retroreflective article of Applicants' invention.

It is, thus, asserted that claims 19-21, dependent from claim 15, are non-obvious over Eigenmann in view of Wyckoff and Jonnes. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner rejected claims 1-9, 13-18, and 21-24 under 35 U.S.C. §103(a) as being unpatentable over Eigenmann (U.S. Patent No. 4,129,673) in view of Wyckoff (U.S. Patent No. 5,108,218). Applicants respectfully traverse this rejection.

As submitted above, Applicants maintain that there is no motivation to combine the teachings of Eigenmann with those of Wyckoff, and any such combination may be made only through impermissible hindsight reconstruction.

Furthermore, even if such a combination was made, a combination of Eigenmann with Wyckoff fails to teach or suggest each and every element of Applicants' claims.

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As discussed above, Eigenmann fails to teach a unitary retroreflective article having a width that is substantially equal to the first portion width as recited in claim 1 and those claims dependent thereto. Wyckoff teaches a roadway marking strip including a rubber sheet coated with glass beads, thus also fails to teach a unitary retroreflective article having a width that is substantially equal to the first portion width. As Wyckoff fails to teach that which is missing from Eigenmann, Applicants assert that claim 1 and claims 2-9, 13, and 14 dependent directly or ultimately therefrom are non-obvious over Eigenmann in view of Wyckoff.

As discussed above, both Eigenmann and Wyckoff fail to teach a composite pavement marking that, *inter alia*, includes: a plurality of discrete first portions surrounded by a second portion, each of the plurality of first portions comprising a discrete unitary retroreflective article attached thereto, as recited in claim 15. Applicants maintain, therefore, that claim 15, as well as claims 16-18 and 21-22 dependent thereto, are non-obvious over Eigenmann in view of Wyckoff.

Claim 23 recites, *inter alia*, a composite pavement marking including a unitary retroreflective article attached to the first portion of the pavement marking wherein the unitary retroreflective article extends along substantially all of the marking length. For similar reasons that neither Eigenmann nor Wyckoff teach or suggest a composite pavement marking including a unitary retroreflective article having a width that is substantially equal to the first portion width, neither document teach or suggest a composite pavement marking including a unitary retroreflective article wherein the unitary retroreflective article extends along substantially all of the marking length. As a combination of Eigenmann and Wyckoff fails to teach or suggest all elements of claim 23, both claim 23 and claim 24 dependent thereto are non-obvious in view of Eigenmann and Wyckoff.

Finally, the Examiner stated that it would have been an obvious matter of design to change the size of the unitary retroreflective article to have a width substantially equal to the first portion since such a modification would have involved a "mere change in the size of a component." Applicants disagree.

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First, there is no motivation for one of ordinary skill in the art to make such a modification, as there is no suggestion whatsoever in any of the cited documents that the retroreflective elements taught are not fully satisfactory for the intended purpose. Second, Applicants submit that the unitary retroreflective elements as claimed provide unexpected results. As disclosed in the present specification at, for example, page 8, lines 9-13, unitary retroreflective articles of the present invention provide an advantage that they may exhibit improved retroreflectivity when wet.

For the foregoing reasons, Applicants respectfully submit that claims 1-9, 13-18, and 21-24 are nonobvious over Eigenmann in view of Wyckoff. Reconsideration and withdrawal of this rejection is, therefore, respectfully requested.

Response to Arguments

In the present Office Action, at pages 10-12, the Examiner states that a particular shape of a prior invention carries no patentable weight unless the new shape provides significant unforeseen improvements in the invention, and that it would have been obvious "to change the shape of the pavement road marker to retroreflective elements attached to protrusions and separated by a valley area in the second portion." It is not clear to Applicants to what change in shape the Examiner refers.

Applicants invention is directed to composite pavement markings including a unitary retroreflective article attached to the first portion of the pavement marking wherein the unitary retroreflective article has a width that is substantially equal to the first portion width (claim 1) and composite pavement markings including a unitary retroreflective article attached to the first portion of the pavement marking wherein the unitary retroreflective article extends along substantially all of the marking length (claim 23). Applicants have made no assertion regarding the shape of the unitary retroreflective articles beyond what has been recited in the claims.

Clarification of the Examiner's assertions regarding changing "the shape of the pavement

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road marker to retroreflective elements attached to protrusions and separated by a valley area in the second portion" is earnestly requested.

Additionally, in the present Office Action, at page 9, paragraph 3, the Examiner stated that, "[i]n response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the retroreflective elements extending along the marking length of the roadway surface marking tape) are not recited in the rejected claim(s)." Applicants respectfully point out that the discussion regarding Applicants' unitary retroreflective article extending along the marking length of the composite pavement marking (Amendment and Response filed September 15, 2003, page 9, paragraph 4 to page 10, paragraph 2) was in reference to Applicants' claim 23, which does recite that the unitary retroreflective article extends along substantially all of the marking length.

For at least the foregoing reasons, Applicants respectfully submit that present claims 1-24 are non-obvious and patentable over Eigenmann in view of either Wyckoff or Jonnes, or over Eigenmann in view of Wyckoff and Jonnes. Reconsideration and withdrawal of the above rejections are, therefore, respectfully requested.

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Summary

It is respectfully submitted that the pending claims 1-24 currently under examination are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for

Eric E. RICE et al.

By

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By:

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Name:

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